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10/563,374	02/21/2006	Katsuyuki Amano	126302	8824
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/563,374

Applicant(s)

AMANO ET AL.

Examiner

AMJAD ABRAHAM

Art Unit

1791

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-19 is/are pending in the application.
- 4a) Of the above claim(s) 11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-19 is/are rejected.
- 7) ☒ Claim(s) 8-10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 01/26/2006 and 07/03/2008
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I, claims 1-10 and 12-19 in the reply filed on 01/16/2009 is acknowledged. The traversal is on the ground(s) that the subject matter in the remaining nonelected claims is "very related technically" to the elected claims. This is not found persuasive because the subject matter of the product claim of claim 11 differs in scope from the presented process claims because claim 11 does not include the use of a material flow connection that is utilized and removed in the process claims of the instant application. Therefore the window assembly in claim 11 can be made from another process which does not utilize a material flow connection, such as a process with separate cavities to mold each piece to be molded individually.

The requirement is still deemed proper and is therefore made FINAL.

Claim Objections

2. Applicant is advised that should claims 1-3 be found allowable, claims 8-10 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. *Claims 1-3, 5, 8-10 and 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu (JP Patent Publication 02-254013 A—Made of record by the applicant and translated by USPTO).*

6. Regarding claim 1-3 and 8-10, Akatsu discloses a method for manufacturing windows for vehicles that are mounted by fastening to a body panel. **(See field of invention on page 1).**

- a. With respect to claims 1 and 8
 - i. Akatsu goes on to teach the following method comprising:

- (1) Adding members to a window pane/frame assembly. (See page 1, "claims" and "problems solved by invention")
- (2) An adhesive applying step. (See claims on page 1).
 - (a) Wherein the adhesive is applied to molding locations to predetermined locations (molding locations) that are formed at the peripheral edge of the window plate.
 - (b) Additionally, the areas in which adhesive are to be applied include the covering member (frame portion) and the positioning member (stopper and holding portion).
Moreover, Akatsu teaches that adhesives can be applied to all molding locations other than the connecting portion. (See page 2- "effect").
- (3) A Forming step. (See page 1 – "claims", discussing resin molding operation).
- (4) Using a mold with the following cavities: (1) Covering member (frame portion) cavity, (2) Holding portion cavity, and (3) polymer material flow (connecting portion) cavity which communicate with each other. (See page 1- "claims")
- (5) Polymer material (liquid resin material) is injected. (See page 1- "claims").

(6) With a step of removing the material flow connection (connection portion) after the injection molding step. (See page 1- "claims").

ii. With respect to claim 1, Akatsu does not explicitly teach wherein the adhesive apply step is added continuously with a predetermined adhesion connection area.

iii. However, it would have been obvious to one having the ordinary skill in the art to alter the separate adhesion application steps taught in Akatsu by using continuous adhesion in order to minimize the preparation time prior to injection molding. Furthermore, it would have been obvious to one having the ordinary skill in the art to do so because where the result accomplished is substantially the same, steps taken concurrently or simultaneously are the equivalent of and not patentable over steps taken successively. *New Wrinkle, Inc. v. Watson, 96 USPQ 436, 437.*

(7) As it pertains to this case, it would have been obvious to one having the ordinary skill in the to alter the teachings of Akatsu to utilize a continuous adhesive application step in order to reduce manufacturing time by adding a:: the adhesive in a single manufacturing step while still ensuring that there is no adhesive added to the material flow connection portion.

b. Additionally regarding claims 2 and 9, which differs from claim 1 in that the positioning member is attached to the holding portion after the forming step.

iv. While Akatsu does not disclose this additional limitation, it would have been obvious to do so by one having the ordinary skill in the art because molding the positioning member as an insert simultaneously with forming the holding portion is the same as an installation after molding.

(8) Furthermore, it has been held that rearranging parts of an invention is obvious to one having the ordinary skill in the art, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

c. Additionally regarding claims 3 and 10, which differs from claim 1 in that no holding portion is utilized as the positioning member is prepared in advance and applied directly to the adhesion section.

v. Akatsu teaches the fact that the positioning member (**Stopper**) is adhered to the adhesion area. (**See page 1- "claims"**).

vi. On the other hand, Akatsu does not explicitly disclose wherein no holding portion is utilized. However, it would have been obvious to one having the ordinary skill in the art to make the invention without a holding portion because one would realize that the function of the holding portion is to add additional support to the positioning member and that the adhesive addition can support the member by itself.

7. Regarding claims 5, 14, and 15, Akatsu does not explicitly teach that the window pane is moved in the adhesive applying step while an applying head for applying the adhesive to the window pane is fixed to a position.

- d. However, it would have been obvious to do so because relative movement of a window pane and adhesive application device is routine determination made solely as a matter of design. Furthermore, applying an adhesive is a well known endeavor in the art of adding resinous members to a window assembly and that there is a finite number of identifiable solutions such as manual application, using a robotic applicator that moves, or moving the window assembly with the applicator being stationary. Thus, the movement of the window pane in the adhesive applying step would have been obvious because a person having the ordinary skill in the art has good reason to pursue known option within his or her grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.
8. *Claims 4, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu (JP Patent Publication 02-254013 A—Made of record by the applicant and translated by USPTO Certified translator Irina Knizhnik) in view of Yokota et al. (USP No. 5,676,898).*
9. Regarding claims 4, 12, and 13, Akatsu does not explicitly teach that in the adhesive applying step, an application range of the adhesive applied to the predetermined adhesion area of the positioning member of the window pane and/or the predetermined adhesion area of the holding portion is broader than an outer

configuration of an end face of the positioning member and/or the holding portion at the adhesive side.

e. However, Yokota teaches that a sufficient thickness of an adhesive should be applied to a resinous member that is attached to window plate in order to absorb vibrations. (See column 10 lines 27-54).

f. Thus, it would have been obvious to one having the ordinary skill in the art to apply adhesive to a broader area because one would have been motivated to apply an adhesive that would sufficiently cover members that are attached to the window pane because using an adhesive agent with sufficient thickness is an important design consideration in order to fully absorb vibrations and ensure sufficient bonding strength.

10. *Claims 6, 16, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu (JP Patent Publication 02-254013 A—Made of record by the applicant and translated by USPTO Certified translator Irina Knizhnik) in view of Hashimoto (Japanese patent Publication JP 2002-096633—made of record by the applicant).*

11. Regarding claims 6, 16, and 17, Akatsu does not explicitly teach that in the forming step, a tab is formed integrally on the material flow connection portion formed by the polymer material flow cavity so as to protrude in such a direction as to depart from the back surface of the window pane.

g. However, Hashimoto discloses a connection part **(24)** which acts similar to the claimed tab as the connection part is removed from the window assembly.

(See abstract and drawings 1-6).

h. A tab formed integrally with a material flow connection and the curved connection part disclosed in Hashimoto serve the same function in substantially the same way as the purpose for both constructions is to facilitate easy removal post mold operation. Therefore, it would have been obvious for one having the ordinary skill in the art to use a tab or equivalent thereof to all for easier post mold removal of the connection part.

12. *Claims 7, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Akatsu (JP Patent Publication 02-254013 A—Made of record by the applicant and translated by USPTO Certified translator Irina Knizhnik) in view of Fisher et al. (USP No. 5,544,458).*

13. Regarding claims 7, 18, and 19, Akatsu does not explicitly teach comprising that at least a part of the window pane to which the adhesive is applied is previously heated in the forming step.

i. However, Fisher teaches that adhesive primers used to connect resinous members to window assemblies achieve improved adhesion when being heated.

(See abstract and column 7 lines 8-18).

j. It is well known in the art that heating adhesives will lead to strengthened adhesive force and bonding. Therefore, it would have been obvious to one having the ordinary skill in the art to alter the teachings of Akatsu to preheat the window pane in order to achieve superior adhesive bonding.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to AMJAD ABRAHAM whose telephone number is (571)270-7058. The examiner can normally be reached on Monday through Friday 8:00 AM to 5:00 PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AAA

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791